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DAE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/699,402 Confirmation No. : 6990
First Named Inventor : Masahiro MATSUO
Filed : October 31, 2000
TC/A.U. : 2131
Examiner : A K MOORTHY
Docket No. : 038849.49341US
Customer No. : 23911
Title : Network Apparatus

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully submits that the finality of the Office Action issued on April 28, 2005, is improper and should be withdrawn. Specifically, the Office Action issued April 28, 2005 includes a new grounds of rejection of an unamended claim and new grounds of rejection of claims which were amended, but the amendments did not necessitate the new grounds of rejection. Accordingly, Applicant respectfully requests that a new Office Action be issued with a new period for reply.

MPEP § 706.07(a) states that

a second or any subsequent action on the merits on any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an Information Disclosure Statement filed under 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p), of any claim not amended by Applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

In the Office Action issued on November 4, 2004, claims 1-23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,509,908 to Croy et al. In response to this Office Action, Applicant amended dependent claims 2 and 22 into independent form by incorporating the elements of the independent claims from which they depended, and the independent claims were canceled. Independent claim 6 was not amended.

On April 28, 2005, a final Office Action was issued rejecting claims 2-11 and 16-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,882,299 Allport¹, and claims 22 and 23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,772,394 to Kamada.

Because the final Office Action issued on April 28, 2005, and relies upon Allport to reject Applicant's claim 6, which was not amended in response to the rejection in the Office Action of November 4, 2004 by Croy, the finality of the April 28, 2005 Office Action is improper and should be withdrawn.

Moreover, the finality of the Office Action is improper with regard to the amendments to claims 2 and 22. Specifically, MPEP § 706.07(a) states that

second or any subsequent actions on the merits shall be made final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).

¹ Although the header of this rejection does not mention claim 6, the body of the rejection references claim 6, the Office Action summary indicates claim 6 is rejected, and there are no other rejections of claim 6 contained in the Office Action. Accordingly, it is assumed that the omission of claim 6 from the header of the rejection is a typographical error.

As discussed above, claims 2 and 22 were amended into independent form by including all of the elements of claims 1 and 21 respectively. Because claims 2 and 22, as dependent claims, necessarily included the elements of claims 1 and 21 respectively, these claims were previously considered by the Examiner in the rejection by Croy. Accordingly, these amendments could not have necessitated the new grounds of rejection.

For at least those reasons stated above, it is respectfully submitted that the finality of the Office Action issued on April 28, 2005, is improper and should be withdrawn.

Although it is not believed that any fees are due in connection with this petition, the Director is hereby authorized to charge any deficiency in fees to Deposit Account No. 05-1323 (Docket # 038849.49341US).

Respectfully submitted,

May 6, 2005



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